



LIPSITZ & McALLISTER, LLC

INTELLECTUAL PROPERTY ATTORNEYS

BRADFORD GREEN, BUILDING 8
755 MAIN STREET
MONROE, CONNECTICUT 06468

AF IFW

BARRY R. LIPSITZ
DOUGLAS M. McALLISTER

TELEPHONE: (203) 459-0200
FACSIMILE: (203) 459-0201

In re Application of: **S. Payne**
Application No.: **10/802,351**
Filed: **March 16, 2004**
For: **A PRINTER HAVING A CONFIGURABLE TEMPLATE AND METHODS FOR
CONFIGURING A PRINTER TEMPLATE**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Art Unit: **2625**
Examiner: **N. McLean**

Sir:

Transmitted herewith is:

- ☒ [X] A Response After Final in the above-identified application (5 pages);
- ☒ [X] Return receipt postage prepaid postcard;
- ☒ [X] I certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: **Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 10, 2008.**

The Commissioner is hereby authorized to charge any deficiency in the payment of the required fee(s) or credit any overpayment to Deposit Account No. 50-0625.

Very truly yours,

Douglas M. McAllister
Attorney for Applicant(s)
Registration No. 37,886
Lipsitz & McAllister, LLC
755 Main Street
Monroe, Connecticut 06468
(203) 459-0200

Attorney Docket No.: **TRA-128**



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
S. Payne) Examiner: N. McLean
)
Application No.: 10/802,351) Art Unit: 2625
)
Filed: March 16, 2004)
)

**For: A PRINTER HAVING A CONFIGURABLE TEMPLATE AND METHODS FOR
CONFIGURING A PRINTER TEMPLATE**

MAIL STOP: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Mail Stop: AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 10, 2008.
Signature: Carol Prentice
Carol Prentice

RESPONSE AFTER FINAL

Dear Sir:

This Amendment is responsive to the final Office Action mailed on September 22, 2008. Claims 1, 2, 6-21, and 25-38 are pending.

As a preliminary matter, Applicant would like to thank the Examiner for the courteous and productive telephone interview held on December 10, 2008, the details of which are set forth below.

Claims 1, 6, 7, 10-15, 18-20, 25, 29-34, 37, and 38 are rejected under 35 U.S.C. § 103(a) as being anticipated by Gauthier (US 2002/0122205, hereafter Gauthier '205) in view of Gauthier (US 6,687,016, hereafter Gauthier '016).

Claims 2, 16, 17, 21, 35, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gauthier '205 and Gauthier '016 in view of Sansone (US 6,373,587).

Claims 8, 9, 27, and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gauthier '205 and Gauthier '016 in view of Leone (US 2003/0002081)

Applicants respectfully traverse these rejections in view of the following comments.

Summary of December 10, 2008 Telephone Interview

On December 8, 2008 Applicant's undersigned counsel telephoned the Examiner to discuss the rejection of claim 1 in view of Gauthier '205 and Gauthier '016. In particular, Applicant's counsel pointed out to the Examiner that newly cited Gauthier '016 is related to Gauthier '205 and in fact has the identical specification as Gauthier '205. Accordingly, Applicant's counsel pointed out that, since the Examiner apparently accepted the arguments presented in the Amendment filed on June 16, 2008 distinguishing the present claims from the disclosure of Gauthier '205, the rejection under section 103 based on the combination of Gauthier '205 and Gauthier '016 is not appropriate.

The Examiner agreed to review the matter with his supervisor. After reviewing the matter with his supervisor, the Examiner called Applicant's counsel on December 10, 2008, and indicated his agreement that the final rejection based on a combination of Gauthier '205 and Gauthier '016 was in error. The Examiner agreed that, upon receipt of a written response to the final Office Action indicating the foregoing, the Examiner would withdraw the final Office Action and issue a further non-final Office Action or Office Communication.

Discussion of Section 103(a) Rejection in View of Gauthier '205 and Gauthier '016

Claims 1, 6, 7, 10-15, 18-20, 25, 29-34, 37, and 38 stand rejected under 35 U.S.C. § 103(a) as being anticipated by Gauthier '205 and Gauthier '016. As discussed with the Examiner, both Gauthier '205 and Gauthier '016 are related applications (Gauthier '205 is a continuation of 09/299,502 and Gauthier '016 is a divisional of 09/299,502) and have identical disclosures. Accordingly, as agreed with the Examiner, the section 103 rejection based on these references is in error.

In addition, the arguments presented in Applicant's June 16, 2008 Amendment therefore

apply equally to Gauthier '205 and Gauthier '016.

In particular, both Gauthier references disclose a method for utilizing variable data with a page description language which enables a template and graphics state for a page of variable data to be defined and stored. A bit map of non-variable background graphics and text, referred to as a template, is generated for the page. At the last code command, which in PostScript is typically SHOWPAGE, the control task terminates the PostScript interpreter and the template is reserved (i.e., stored) in a database (see, e.g., paras. 0009 and 0014 of Gauthier '205; and Col. 2, lines 28-29 and Col. 3, lines 22-27 of Gauthier '016). A merge task merges a data bit map into the stored template (see, e.g., para 0015 of Gauthier '205 and Col. 3, lines 29-47 of Gauthier '016).

The aim of both Gauthier references is to "have a method for processing variable data wherein once defined, the template and graphics states for a page can be stored and reused for printing subsequent pages" (para. 0008 of Gauthier '205 and Col. 2, lines 18-21 of Gauthier '016). Thus, in both Gauthier references, the template itself is stored in printer memory.

In contrast, with Applicant's claimed invention according to claim 1, template attributes are provided to the printer memory and the template is created at the printer from the stored template attributes. Data is then provided to the printer memory and this data is merged into the template to form a composite image for printing. Thus, with Applicant's claimed invention, there is no need to store the entire template in memory as in Gauthier '205 and Gauthier '016. Rather, with Applicant's claimed invention, the template attributes are provided to the printer memory and the template is created at the printer prior to printing. Such an approach enables a greater degree of flexibility than that provided by the system of Gauthier, since in Gauthier the printer can only print data in the particular templates that are stored in the memory, while with Applicant's invention the template is created by the printer based on the template attributes provided, enabling a wide variety of template forms.

Accordingly, neither Gauthier reference (taken alone or in combination) discloses or remotely suggests providing template attributes to memory of the printer and creating a template

at the printer from the attributes provided.

The foregoing arguments apply equally to Applicant's independent claim 20, which specifies that the printer comprises a processor for creating a template from the template attributes.

Accordingly, Gauthier '205 and Gauthier '016, taken in combination, do not disclose or suggest each and every element of the invention as claimed, the rejections under 35 U.S.C. § 103(a) are believed to be improper, and withdrawal of the rejections is respectfully requested.

Applicants respectfully submit that the present invention would not have been obvious to one skilled in the art in view of Gauthier '205 and Gauthier '016, or any of the other prior art of record.

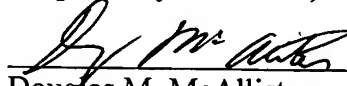
Further remarks regarding the asserted relationship between Applicants' claims and the prior art are not deemed necessary, in view of the agreement reached during the telephone interview and the foregoing discussion. Applicants' silence as to any of the Examiner's comments is not indicative of an acquiescence to the stated grounds of rejection.

Withdrawal of the rejections under 35 U.S.C. § 103(a) is therefore respectfully requested.

Conclusion

The Examiner is respectfully requested to reconsider this application, allow each of the pending claims and to pass this application on to an early issue. If there are any remaining issues that need to be addressed in order to place this application into condition for allowance, the Examiner is requested to telephone Applicants' undersigned attorney.

Respectfully submitted,



Douglas M. McAllister
Attorney for Applicant(s)
Registration No. 37,886
Lipsitz & McAllister, LLC
755 Main Street
Monroe, CT 06468
(203) 459-0200

ATTORNEY DOCKET NO.: TRA-128

Date: December 10, 2008